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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,369	02/28/2000	Takayuki Shinohara	49657-625	9468

20277            7590            07/21/2003  
**MCDERMOTT WILL & EMERY**  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER
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LEI, TSULEUN R

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 07/21/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/514,369	SHINOHARA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	TSULEUN R. LEI	2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 June 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Applicant's request for reconsideration filed on 6/9/03 has been fully considered but they are not persuasive for the following reasons.

Applicant argues that Kuroda reference does not teach that the flash memory is a file storage flash memory for storing a program for the control portion, and transmission and reception data in a non-volatile manner under a control of the control portion, and further argues that the part that the Examiner relies upon to reject the claim is about a microcomputer rather than a telephone device. It should be kept in mind that Kuroda teaches the flash memory circuit and its implementation in various devices, including a cordless phone, and the part of the teaching about a microcomputer also applies to the implementation of such teaching, such as the telephone device. The telephone device of Kuroda reference contains a CPU, hence every function of the CPU taught by Kuroda also applies to the telephone.

Applicant further argues that Kuroda does not teach or suggest the claimed file storage flash memory for storing program for the control portion. This is not true. Kuroda repeatedly teaches that the flash memory stores not only the data, but also the program to be executed by the CPU (Col.5, Lines 30-33; Col.6, Lines 21-23).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 7, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroda et al. (U.S. Patent 5,444,664).

Regarding Claim 1, Kuroda teaches a memory system for a portable telephone (Col.5, Lines 11-14; Fig.41) including a signal transmission/reception portion for transmitting and receiving a signal (Fig.41, High-Frequency Radio Unit 103) and a control portion (It is inherent that the High-frequency radio unit 100 must have a built-in control circuit.) for controlling at least a signal transmission and reception operation of said transmission/reception portion, comprising: a random access memory (Col.6, Lines 17-23) providing a working area for said control portion; and a file storage flash memory (Fig.41, FLASH) for storing a program for said control portion and at least transmission and reception data in a non-volatile manner under a control of said control portion (Col.6, Lines 21-23, desired data and program.).

Regarding Claim 2, Kuroda teaches the memory system for the portable telephone according to claim 1, wherein said random access memory and said file storage flash memory are coupled to an internal bus interconnecting said control portion and said signal transmission/reception portion (It is inherent, as can be seen in Fig.41, that the RAM and the flash memory are coupled to an internal bus interconnecting all major parts of the mobile phone, including the control portion and the transmission/reception portion.)

Regarding Claim 7, Kuroda teaches the memory system for the portable telephone according to claim 1, wherein said file storage flash memory comprises an AND type flash memory (Col.9, Lines 43-47).

Regarding Claim 9, Kuroda teaches the memory system for a portable telephone according to claim 1, wherein said file storage flash memory comprising a plurality of sectors for storing a program for said control portion (Figs.37-39) and at least transmission and reception data in a non-volatile manner under a control of said control portion, and serially reading out a program to the random access memory to execute it (Col.5, Lines 30-32, Note that “the stored information to be processed by the CPU” indicates that the stored program bits are read out from the memory and into the CPU in a serial fashion as shown in Fig.28).

Regarding Claim 10, see Claim 1 and Claim 9 for Kuroda’s teaching.

Regarding Claim 11, see Claim 1 for Kuroda’s teaching.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda.

Regarding Claim 3, Kuroda teaches the memory system for the portable telephone according to claim 2, but is silent about further comprising a bus converting circuit connected between said file storage flash memory and said internal bus and functioning as an interface circuit for said file storage flash memory. However, interface circuit is always needed in an electronic device when bus is used to interconnect different components in the device. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have included such bus converting circuit to the Kuroda's teaching.

Regarding Claim 4, Kuroda teaches the memory system for the portable telephone according to claim 3, wherein said file storage flash memory and said bus converting circuit are integrally formed into a memory card (Fig.43 shows a memory card, and the bus converting circuit could be part of the input/output circuit shown as I/O in Fig.43; Col.34, Lines 11-13) attachable and detachable to and from said portable telephone.

Regarding Claim 5, Kuroda teaches the memory system for the portable telephone according to claim 3, wherein said file storage flash memory is constituted of a memory card (Fig.43 shows a memory card, and the bus converting circuit could be designed not as a part of the input/output circuit shown as I/O in Fig.43, but as a part of the bus circuit in the mobile phone; Col.34, Lines 11-13) being attachable and detachable to and from said bus converting circuit.

Regarding Claim 6, Kuroda teaches the memory system for the portable telephone according to claim 1, but is silent on said control portion, said random access memory and said file storage flash memory being integrally formed as a control unit. However, it is a design choice, and it would have been obvious for one of ordinary skill in the art at the time the invention was made to have said control portion, said random access memory and said file storage flash memory being integrally formed as a control unit in the device taught by Kuroda.

Regarding Claim 8, Kuroda teaches the memory system for the portable telephone according to claim 5, wherein said bus converting circuit is attachable and detachable to said

portable telephone (Col.34, Lines 34-35, Note: replaceable indicates that it is attachable and detachable). Kuroda does not teach that the bus converting circuit is formed into an adapter. However, it is a design choice that the bus converting circuit can be built into the mobile phone's bus circuit, or on the memory card, or being independent of either and by itself as an adapter between the phone and the memory card. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have the bus converting circuit formed into an adaptor to interconnect the mobile phone and the memory card as taught by Kuroda.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ogura et al. (U.S. Patent 6,189,056)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Richard Lei whose telephone number is 703-305-4828. The examiner can normally be reached on 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 703-305-4778. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and 703-308-5403 for After Final communications.

Art Unit: 2686

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TRL  
July 10, 2003

*Marsha D. Banks-Harold*  
MARSHA D. BANKS-HAROLD  
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